

Remarks

This Application has been carefully reviewed in light of the Office Action dated February 26, 2004. Applicant appreciates the Examiner's consideration of the Application. Although Applicant believes all pending claims are allowable without amendment, in order to expedite allowance, Applicant has made clarifying amendments to Claims 1, 12, 20, and 28. Certain of these amendments are not narrowing and none are considered necessary for patentability. Applicant has also added new Claims 29-42, none of which introduce any new matter. Applicant also respectfully provides these remarks. Applicant respectfully requests reconsideration and allowance of all pending claims.

Information Disclosure Statement

A Request for Consideration of an Information Disclosure Statement (IDS) Timely Filed was mailed to the Examiner on March 9, 2004, requesting that the Examiner consider a reference cited by Applicant in an IDS mailed December 23, 2003. Applicant received a communication from the Examiner mailed May 10, 2004, which included a copy of the PTO-1449 sent by Applicant and an indication that the Examiner considered the cited reference (the Examiner's initials next to the cited reference). Applicant appreciates the Examiner's consideration of the cited reference.

Applicant's Claims are Allowable over the Section 103 Rejections

The Examiner rejects Claims 1-4, 6-15, 17-23, and 25-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication 2003/0050958 A1 to Keller et al. ("*Keller*") in view of U.S. Publication 2001/00496765 A1 to Mandler, et al. ("*Mandler*"). Applicant respectfully disagrees.

At the outset, Applicant notes that Applicant could antedate *Keller* based at least on Applicant's date of conception prior to September 10, 2001 (the filing date of *Keller*) and subsequent diligence up to the October 23, 2001 filing date of the Application. While Applicant has chosen not to do so in the present Response due to the clear distinctions between Applicant's claims and *Keller* discussed below, Applicant reserves the right to antedate *Keller* in a future Response or on Appeal, if appropriate.

The Proposed Combination of References

Fails to Meet the Limitations Recited in Applicant's Claims

Keller merely discloses a system for providing retailers a way to electronically place orders with a supplier (i.e. a manufacturer) without requiring the retailer to implement Electronic Data Interchange (EDI) or another electronically-enabled transaction protocol used by the manufacturer. (See Page 1, Paragraph 0010) The system disclosed in *Keller* includes an on-line facility that provides retailer customers of a supplier with information about the status of transactions involving products of the supplier. (See Page 1, Paragraph 0004) The status information is provided from a database, which is updated automatically by the on-line facility to reflect transactions involving the retailer. (See Page 1, Paragraph 0004)

Applicant respectfully submits that *Keller* is wholly inadequate as a reference against independent Claim 1. Thus, even assuming for the sake of argument that *Mandler* disclosed the portions of Claim 1 referenced by the Examiner (which, as discussed below, Applicant disputes), and even assuming for the sake of argument that there was the required teaching, suggestion, or motivation to combine *Keller* with *Mandler* as the Examiner proposes (which, as discussed below, Applicant disputes), the proposed *Keller-Mandler* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1, as is required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

For example, nowhere does the proposed *Keller-Mandler* combination disclose, teach, or suggest "an intelligence module operable to create one or more generic documents capable of being used to facilitate a future transaction with at least one of the sellers from one or more of the transaction documents stored in the one or more document repositories, a generic document created from a transaction document comprising the transaction document with selected information in the transaction document made inaccessible in the generic document," as recited in Claim 1 as amended. The portion of *Keller* cited by the Examiner as teaching this limitation merely discloses the processing of messages received from a manufacturer according to the system disclosed in *Keller*. (Page 5, Paragraph 52) For example, an acknowledgement sent by the manufacturer to the transaction server in response to an order

received from a retailer via the transaction server is converted from the manufacturer's specific format (e.g., EDI) to an XML format. (Page 5, Paragraph 52) The converted document is probed for key data elements (e.g., customer, document type, document version), which are used to create a message envelope for sending, along with the XML document, to the transaction server. (Page 5, Paragraph 52)

Keller fails to disclose, teach, or suggest any module "operable to create one or more generic documents . . . from one or more of the transaction documents stored in the one or more document repositories," let alone that the generic documents are "capable of being used to facilitate a future transaction with at least one of the sellers" or that "a generic document created from a transaction document compris[es] the transaction document with selected information in the transaction document made inaccessible in the generic document," as recited in Claim 1 as amended. The XML documents created by the system disclosed in *Keller* are nothing more than a conversion of the protocol-specific (i.e. EDI) documents sent by the manufacturer. Even if the XML document disclosed in *Keller* could be equated with the "generic document" disclosed in Claim 1 as amended, which Applicant disputes, *Keller* would still fail to disclose, teach, or suggest that the XML document is "capable of being used to facilitate a future transaction with at least one of the sellers" and "created from a transaction document comprising the transaction document with selected information in the transaction document made inaccessible in the generic document," as recited in Claim 1 as amended. The XML documents disclosed in *Keller* are merely used to populate a transaction log table for the manufacturer, which includes a summary of prior transactions of the manufacturer. (See Page 5, Paragraphs 0052-0053) *Mandler* fails to account for this deficiency of *Keller*. Accordingly, the proposed *Keller-Mandler* combination fails to disclose, teach, or suggest the intelligence module as specifically recited in Claim 1 as amended.

The Examiner acknowledges, and Applicant agrees, that *Keller* fails to disclose, teach, or suggest "a search interface operable to communicate a search query for transaction documents to one or more document repositories identified by one or more pointers associated with one or more selected classes," as recited in Claim 1 as originally filed. (Office Action, Page 3) However, the Examiner argues that *Mandler* does teach this

limitation. (Office Action, Page 3) Applicant respectfully disagrees. The portion of *Mandler* cited by the Examiner as teaching this limitation merely discloses querying *an index* (i.e. postings 38 and 40 of index 28) of documents organized in the dynamic directory structure disclosed in *Mandler*. However, nowhere does *Mandler* disclose, teach, or suggest “a search interface operable *to communicate* a search query for transaction documents *to one or more document repositories identified by one or more pointers associated with one or more selected classes*,” as recited in Claim 1 as amended.

The Proposed Combination of References is Improper

Furthermore, Applicant respectfully submits that there is no required teaching, suggestion, or motivation to combine *Keller* with *Mandler* as the Examiner proposes. In particular, Applicant respectfully submits that the Examiner's conclusory assertion that it would have been obvious to combine the teachings of *Keller* with the teachings of *Mandler* to arrive at Applicant's invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art

reference (or references where combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant’s disclosure. *See Id.* (citations omitted). “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the examiner to show a motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

The Examiner states, "It would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to combine Mandler's reference into Keller's by implementing the transaction documents into a hierarchical structure in file folder format because by doing so the transactions of documents would have been more direct and efficient since it would have eliminated the process of storing the transaction documents into a database and bypassed the use of sql query for retrieving business transactions." (Office Action, Page 3) However, the Examiner has not identified anything in *Keller*, *Mandler*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention as allegedly providing a teaching, suggestion, or motivation to modify *Keller* or to combine *Keller* with *Mandler* as the Examiner proposes. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to even attempt* to incorporate into the system disclosed in *Keller* the dynamic directory structure disclosed in *Mandler*. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to actually* incorporate into the system disclosed in *Keller* the dynamic directory structure disclosed in *Mandler*, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law. Applicant respectfully submits that the proposed combination of the teachings of *Keller* with the teachings of *Mandler* appears to be merely an attempt by the Examiner to recreate Applicant's claims in hindsight with the benefit of Applicant's claims as a roadmap for selecting portions of the references.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Keller* with *Mandler* in the manner the Examiner proposes, Applicant

respectfully submits that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with its dependent claims. For substantially similar reasons to those discussed above with reference to independent Claim 1, Applicant respectfully requests reconsideration and allowance of independent Claims 12, 20, and 28, together with their respective dependant claims.

Claims 5, 16, and 24 Depend from Allowable Independent Claims

The Examiner rejects Claims 5, 16, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Keller* in view of *Mandler* in view of U.S. Patent 6,442,574 to Schumacher, et al. ("*Schumacher*"). Claims 5, 16, and 24 depend from independent Claims 1, 12, and 20, which Applicant has shown above to be clearly allowable, and are allowable for at least this reason. Additionally, for similar reasons discussed above with reference to the proposed *Keller-Mandler* combination, Applicant respectfully submits that the Examiner has failed to adequately demonstrate the required motivation to combine or modify the proposed *Keller-Mandler* combination with *Schumacher*. Furthermore, even if the proposed *Keller-Mandler-Schumacher* combination could be made, Claims 5, 16, and 24 recite further patentable distinctions over the proposed *Keller-Mandler-Schumacher* combination. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 12, and 20, Applicant does not specifically discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 5, 16, and 24.

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the proposed *Keller-Mandler* and *Keller-Mandler-Schumacher* combinations. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on

Appeal, if appropriate. The example distinctions discussed by Applicant are sufficient to overcome the obviousness rejections.

New Claims 29-42 are Allowable

In addition to being dependent on allowable independent claims, new Claims 29-30 (which depend from independent Claim 1), new Claims 31-35 (which depend from independent Claim 12), and new Claims 36-42 (which depend from independent Claim 20) recite further patentable distinctions over the prior art of record. To avoid burdening the record and in view of the clear allowability of independent Claims 1, 12 and 20, Applicant does not specifically discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. For at least these reasons, Applicant respectfully requests consideration and allowance of new Claims 29-42.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant encloses a check for \$252.00 to cover the cost of filing fourteen new claims total over twenty. Although Applicant believes no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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